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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,007	01/20/2004	Kazuma Aoki	118331	6840

25944 7590 02/02/2009

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EXAMINER	
YIP, KENT	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
02/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/759,007	AOKI ET AL.	
	Examiner	Art Unit	
	Kent Yip	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to MPEP 2106.2: **Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.** Therefore, the claimed "computer program" without the computer-readable medium constitutes non-statutory subject matter.

3. Claim 22 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

transforms underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. The **method of communicating** in claim 22 including steps of scanning, recognizing, and transmitting is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The claim does not specify what apparatus performs the above steps and does not transform an article (the data are not articles). For example, the steps could conceivably be interpreted to mean someone visually inspecting a paper form, reading the contents of the form, and verbally communicating the contents of the form to another person standing next to him/her.

Thus, claim 22 is rejected based on the above analysis because they do not in themselves satisfy either of the conditions of eligibility for a § 101 process.

Claims 20-21 were not rejected under 35 U.S.C. 101 because the limitations of **printing the web page as accessed on a first recording medium** and **printing an image of the web page as accessed on a first recording medium** were interpreted as **a transformation of an article** (blank paper to printed paper) thus meeting (2) transform underlying subject matter criteria.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6-9, and 14-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolff et al. USPN 7289685 (Wolff).

6. **Regarding claim 1**, Wolff teaches: A communication system, comprising:

a printing unit that is controlled to print an image on a recording medium (col 3 line 42 printer);

a scanning unit that is controlled to scan an image (col 3 line 42 scanner);

an accessing system that connects with a web page (Fig. 12 ISNdata.com) though a network in response to an operation of a user (col 3 line 2 general purpose computer, col 3 lines 43-44 network connection, col 8 lines 25-30 Fig. 11-12);

a first print controller that controls said printing unit to print the web page accessed by said accessing system on a first recording medium (col 4 lines 5-6 Fig. 1 [102], col 7 lines 15-25 Fig. 11, col 10 lines 30-35);

a second print controller that operates such that, when the web page accessed using said accessing system (col 7 lines 34-35; tXt machine accesses the forms from intermediary service “ISNdata.com” Fig. 11) includes an input field in which data is to be input by the user and the data input in the input field being to be transmitted to a predetermined destination (Fig. 2), said second print controller controls said printing unit to print an image having at least a fill-in area corresponding to the input field, the fill-in

area being to be filled in by the user (col 10 lines 30-35; Fig. 12), and a destination area indicating the destination defined by the web page on a second recording medium (col 5 lines 66-67 to col 6 lines 1-2 Fig. 1 [103]; form can span multiple pages);

a scan controller that controls said scanning unit to scan the second recording medium having been filled in by the user to capture an image thereof (col 4 lines 30-60 Fig. 1 [103-104]);

a recognition system that recognizes contents written in the fill-in area (col 4 lines 45-67) and the destination area based on the image of the second recording medium scanned by said scanning unit under control of said scan controller (col 5 lines 66-67 to col 6 lines 1-2); and

a data transmitting system that transmits contents written in the fill-in area and recognized by said recognition system to the destination printed in the destination area and recognized by said recognition system (col 5 lines 63-67 to col 6 line 1).

7. **Regarding claim 6**, Wolff teaches: The communication system according to claim 1, wherein, when the web page accessed with said accessing system includes a plurality of groups of input fields, the input fields falling within a same group having a same destination, the input fields falling within different groups having different destinations (col 5 lines 66-67 to col 6 lines 1-5 user can override certain destinations identified by forms), said second print controller controls said printing unit to print an image having at least the fill-in area and the destination area on different second

recording mediums for different groups of input fields (col 4 lines 5-6 the form can span multiple pages with multiple groups of input fields).

8. **Regarding claim 7**, Wolff teaches: The communication system according to claim 1, wherein, when the web page accessed with said accessing system includes a plurality of groups of input fields, the input fields falling within a same group having a same destination, the input fields falling within different groups having different destinations (col 5 lines 66-67 to col 6 lines 1-5 user can override certain destinations identified by forms), said second print controller controls said printing unit to print an image having at least the fill-in area and the destination area on the same second recording medium regardless whether the plurality of input fields fall within the different groups (col 4 lines 5-6 the form can span a single page with multiple groups of input fields).

9. **Claims 8-9 and 16** recite identical features as claim 1 respectively, thus, arguments similar to that presented above for claim 1 are equally applicable to claims 8-9 and 16.

10. **Claims 14-15** recite identical features as claims 6-7 respectively, thus, arguments similar to that presented above for claims 6-7 are equally applicable to claims 14-15.

11. **Claims 17-19** recite identical features as claim 1 respectively, except the limitations are embodied in a computer program product (Wolff col 3 lines1-31), thus, arguments similar to that presented above for claim 1 are equally applicable to claims 17-19.

Claims 20-22 recite identical features as claim 1 respectively, except claims 20-22 are method claims. Thus, arguments similar to that presented above for claim 1 are equally applicable to claims 20-22.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2-5 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff as applied to claim 1 above, and further in view of Silverbrook et al. US 2003/0093378 (Silverbrook).

14. **Regarding claim 2**, Wolff teaches: The communication system according to claim 1,

wherein said second print controller is configured to examine whether the web page accessed with said accessing system includes term data representing an effective term of the web page (col 7 lines 15-33 validation requirements), said second print controller controls said printing unit to print an image having a term area related to the term data as well as the fill-in area and the destination area on the second recording medium (Fig. 2 due date),

wherein said recognition system is configured to recognize contents printed in the fill-in area, the destination area (col 7 lines 18-22) and the term area of the image scanned by said scanning unit (col 7 lines 30-33 a valid date),

wherein said communication system further comprises a term examining system that determines whether a current date/time is later than a term that is printed in the term area of the second recording medium and recognized by said recognition system (col 7 lines 15-33 Fig. 2 shows a Due Date and a Date next to the signature. It would be inherent for the server 1103 to compare the dates to meet validation requirements.), and

Wolff does not teach:

wherein said data transmitting system is configured to transmits the contents written in the fill-in area to the destination indicated by the contents in the destination area only when said term examining System determines that the current date/time is on or before the term extracted from the term area of the second recording medium.

Silverbrook teaches:

wherein said data transmitting system is configured to transmits the contents written in the fill-in area to the destination indicated by the contents in the destination area only when said term examining system determines that the current date/time is on or before the term extracted from the term area of the second recording medium (p0253).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Silverbrook into Wolff since Wolff teaches using forms to collect information (col 4 lines 30-33) and Silverbrook also teaches using forms to collect information (p0251) where the forms are kept up to date via a version history (p0254).

15. **Regarding claim 3**, Wolff in view of Silverbrook teach: The communication system according to claim 2, further comprising a notifying system that notifies a user of said communication system that the current date/time is later than the effective term of the web page when said term examining system determines that the current date/time is later than the term extracted from the term area of the second recording medium (Silverbrook p0253 lines 14-16).

16. **Regarding claim 4**, Wolff teaches: The communication system according to claim 1,

wherein said recognition system is configured to recognize contents printed in the fill-in area, the destination area (col 7 lines 18-22), the last-modified time area and

the access data area of the image scanned by said scanning unit (col 7 lines 30-33 a valid date),

wherein said communication system further comprises:

a modified date/time examining system that examines whether the last-modified date/time obtained by said modified date/time obtaining system coincides with a date/time that is printed in the last-modified date/time area and recognized by said recognition system (col 7 lines 30-33 a valid date),

wherein said data transmitting system is configured to transmits the contents written in the fill-in area to the destination indicated by the contents in the destination area only when said modified date/time examining system determines that the last modified date/time obtained by said modified date/time obtaining system coincides with a date/time printed in the last-modified date/time area and recognized by said recognition system (col 7 lines 15-33 Fig. 2 shows a Due Date and a Date next to the signature. It would be inherent for the server 1103 to compare the dates to meet validation requirements.).

Wolff does not teach:

wherein said second print controller is configured to examine whether the web page accessed with said accessing system includes a modified time data representative of a date/time when the contents of the web page were lastly modified, said second print controller controls said printing unit to print an image having a last-modified time area representing the last modified date/time of the web page and an access data area having access data that was referred to when said accessing system accessed the web

page as well as the fill-in area and the destination area on the second recording medium,

a modified date/time obtaining system that obtains the last-modified date/time from the web page with reference to the data in the access data area; and

Silverbrook teaches:

wherein said second print controller is configured to examine whether the web page accessed with said accessing system includes a modified time data representative of a date/time when the contents of the web page were lastly modified (p0254 version history), said second print controller controls said printing unit to print an image having a last-modified time area representing the last modified date/time of the web page and an access data area having access data that was referred to when said accessing system accessed the web page as well as the fill-in area and the destination area on the second recording medium (p0253 lines 1-3),

a modified date/time obtaining system that obtains the last-modified date/time from the web page with reference to the data in the access data area (p0254 version history); and

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Silverbrook into Wolff since Wolff teaches using forms to collect information (col 4 lines 30-33) and Silverbrook also teaches using forms to collect information (p0251) where the forms are kept up to date via a version history (p0254).

17. **Regarding claim 5**, Wolff in view of Silverbrook teach: The communication system according to claim 4, further comprising a notifying system that notifies a user of said communication system (Silverbrook p0253 lines 14-16) that the last-modified date/time obtained by said modified date/time obtaining system does not coincide with a date/time that is extracted from the last-modified date/time area of the second recording medium when said modified date/time examining system determines that the last-modified date/time obtained by said modified date/time obtaining system does not coincide with a date/time printed in the last-modified date/time area of the second recording medium and recognized by said recognition system (Wolff col 7 lines 30-33 a non-valid date according to validation requirements).

18. **Claims 10-13** recite identical features as claims 2-5 respectively, thus, arguments similar to that presented above for claims 2-5 are equally applicable to claims 10-13.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Yip whose telephone number is (571) 270-5244. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman can be reached on (571) 272-7653. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kent Yip/
Examiner, Art Unit 2625

/Mark K Zimmerman/
Supervisory Patent Examiner, Art Unit 2625